

### **REMARKS**

The final Action of September 25, 2008, has been carefully reviewed.

Applicants note that the Examiner did not honor applicants' request as set forth on page 18 of the Reply filed July 11, 2008, for an interview before any final action, and has therefore prolonged prosecution in this application, causing unnecessary delay. Applicants also believe that the Examiner has interpreted the claims in a way clearly not intended by the applicants as indicated in the remarks of the Reply filed July 11, 2008, as explained in more detail below.

The claims in the application remain as claims 1, 2, 10, 11, 13-20 and 23-28, and the amendments presented above are for the purpose of emphasizing what applicants believe they had already previously claimed, but which the Examiner interpreted in a way inconsistent with applicants' invention. The amendments presented above are thus believed to raise no new issues, as the same issues exist as previously existed. As Applicants' claims define not only novel but also non-obvious subject matter over the prior art, applicants respectfully request favorable reconsideration, entry of the amendments presented above, and allowance.

Claims 1, 2, 10 and 16-20 have again been rejected as obvious from Schmid alone or in view of "Pigment for high performance" (hereinafter "Pigment"). Claims 1, 2, 10, 13, 14, 17, 18, 25 and 26 have again been rejected as obvious under §103 from Andes either alone or in view of "Pigment". Claims 11, 15, 23, 24, 27 and 28 have been rejected as obvious under Schmid in view of Bolger and optionally further in view of "Pigment". These rejections are all respectfully traversed for the reasons of record, respectfully repeated by reference, and further explained below.

The following facts are clear:

- (1) Both Schmid and Andes, the primary references, show pigments having a core with plural layers thereover.
- (2) Applicants have claimed and continue to claim a pigment covered with only a single layer. Thus, appellants pointed out in the first sentence of the second paragraph on page 9 of the last reply:

The independent claims..., and therefore  
all of applicants' claims... specify that only  
one single substrate-enclosing layer is on  
the metallic substrate.

Taking claim 1 as an example of the independent claims, claim 1 clearly recited (at the time of the final rejection) "said layer being the only layer on said metallic substrate." The Examiner has chosen to interpret this clear statement as including another word, double-underlined below, which word does not appear in the claim:

"said layer being the only layer directly on  
said metallic substrate."

Respectfully, this misinterprets what applicants consider to be the clearly intended meaning by adding to the claim something which is not there.

Respectfully, applicants made it very clear, in both the claim language itself and in the arguments presented, that applicants' claimed pigment has a core and only one layer over the core. The claimed subject matter was and is fundamentally different from the primary references in this regard, and the secondary references do not make up for this distinction.

The Examiner states that the word "comprising", being open-ended, permits more layers. This makes no sense when the body of the claim itself clearly sets forth a contrary interpretation.

The Examiner says that "the references teach the pigment with a layer of same material, such as silica, with an overlapping thickness coated on the substrate as applicant disclosed in the instant application, therefore, it would be expected that the pigment disclosed by the references has the same or similar properties absent any evidence to the contrary." But this conclusion by the Examiner ignores the fundamental difference pointed out previously and above. The references have plural layers over the substrate, while the instant invention provides only one layer on (over) the substrate, and there is therefore no basis for concluding that inherency of results exist, it being noted that the law requires "reasonable certainty" for inherency. There is no reasonable certainty that the pigments of the references have the properties of applicants' pigments.

Applicants further note in this regard that there is no rejection based on §102, so the PTO agrees that the claimed pigments are novel. It is therefore factually incorrect to suggest, as appears in the rejection, that the prior art pigments would have the same properties because they are the same as the claimed pigments. They are not the same, and do not have the same properties.

The pigments of the present invention have the self-color of the metal substrate and, consequently, also have a strong gloss as well as a light-dark flop. The pigments of the prior art, e.g. Schmid's pigments, have a thick SiO<sub>2</sub> layer, as this is the only possibility to create the desired interference effects which are the object of Schmid. Therefore, the person of ordinary skill in the art would not consider doing what applicants

have done, including selecting a much thinner SiO<sub>2</sub> layer having a thickness of only 20-50 nm. Irrespective of this difference, Schmid clearly stipulates that a second selectively absorbing coating is applied onto the first coating of SiO<sub>2</sub>.

The rejection states that "a reference can be used for all it realistically teaches and is not limited to only the examples...." This is correct, but such a statement overlooks the fact that a reference should be evaluated on the basis of what it makes obvious to those of ordinary skill in the art, and that takes into account both its negative as well as its positive teachings. As regards the subject matter exemplified in a prior patent, the person of ordinary skill in the art will understand that such exemplified material is what the patentee focused on, and what the patentee thought was most important; and when there are many, many possibilities, and it is impossible to try all of those possibilities, the person of ordinary skill in the art will follow the examples of the prior art as being the strongest teachings. Applicants respectfully maintain the remarks of the preceding reply.

Lastly, and with respect, the commentary at the top of page 5 of the final action sets up a straw man to knock it down. It is entirely proper, and indeed necessary, for an applicant to discuss the references individually, prior to addressing their proposed combinations. The primary references are those primarily relied upon, and applicants have addressed those references primarily. But applicants did not overlook the proposed combinations, noting the paragraph spanning pages 13 and 14 of the preceding Reply, the first full paragraph on page 16 of the preceding Reply, and the top two paragraphs on page 17 of the preceding Reply. To briefly repeat, the secondary references do not make up for the deficiencies of the primary references; and therefore, even if the combinations were obvious

(respectfully not admitted), the reconstructed primary references (i.e. reconstructed in view of the secondary references) would not meet the claimed subject matter.

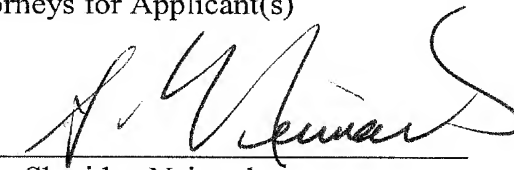
To partially summarize, applicants pigments, having a metallic substrate and only one layer of metal oxide on the metallic substrate, significantly differ from the prior effect pigments of Schmid, and anything also shown by any of the other citations, and no modification provided by any secondary references would change these significant differences.

Applicants claims define not only novel subject matter (implicitly admitted by the PTO), but also define important and non-obvious subject matter constituting an important improvement over the closest prior art. Withdrawal of the rejections is in order and is respectfully requested.

Applicants again respectfully request favorable reconsideration, entry of the amendments presented above, and allowance.

Respectfully submitted,

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